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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,762	03/06/2002	Markus Holzle	52241	7164

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KEIL & WEINKAUF
1350 CONNECTICUT AVENUE, N.W.
WASHINGTON, DC 20036

EXAMINER

MEDINA SANABRIA, MARIBEL

ART UNIT PAPER NUMBER

1754

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/090,762

Applicant(s)

HOLZLE ET AL.

Examiner

Maribel Medina

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 102(f) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over application publication No. 20020169075 (copending application No. 10/090,763). The applicant did not invent the claimed subject matter.

Application publication No. 20020169075 recite the claimed invention. The only difference between the instant claims and the claims of SN 10,090,763 is that the instant claims do not recite the limitation that reads “to an anion content from the precipitating agent of from 0.1 to 2.5% by weight” however the property would have been inherently provided by the instant claims, once the calcinations step is carried out in the method of making the catalyst.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 9 of copending Application No. 10/090,763. Although the conflicting claims are not identical, they are not patentably distinct from each other.

SN 10,090,763 fail to recite the limitation that reads "to an anion content from the precipitating agent of from 0.1 to 2.5% by weight" however the property would have been inherently provided by the instant claims, once the calcination step is carried out in the method of making the catalyst.

SN 10/090,763 fail to recite the following order of steps, reducing, passivating and then reducing the calcined catalysts. However it would have been obvious to one of ordinary skill in the art at the time the invention was made to have carried out the steps in SN 10/090,763 as instantly claimed since claim 1 of the copending application recite that the steps of shaping, reducing and passivating can be carried out in any order (See claim 1, step 3) and since claim 2 of the copending application, recite the instantly claimed steps.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Response to Arguments

6. Applicant's arguments, see paper, filed on 4/1/04, pages 5-6 have been fully considered and are persuasive. The rejections of Claims 1-4, 6 and 8 are rejected under 35 U.S.C. 102(b) as anticipated by US Patent No. 5,928,985 (Williams) and of Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams as applied to claims 1-4, 6 and 8 above, and further in view of US Patent No. 6,051,163 (Kumberger et al) have been withdrawn.

7. Applicant's arguments filed on 4/1/04 have been fully considered but they are not persuasive.

In regards to the Provisional obviousness-type Double Patenting Rejection, applicants' argue that copending application 10/090,763 is not commonly owned (See page 2). This argument is not persuasive since the copending applications do not have to be commonly owned to be rejected under the non-statutory obviousness-type Double Patenting (See MPEP 804)

Applicants' further argue that the claims of copending application 10/090,763 fail to recite the following order of steps, reducing, passivating and then shaping the calcined catalyst. However this argument is not persuasive, since claim 1 of the copending application recite that the steps of shaping, reducing and passivating can be carried out in any order (See claim 1, step 3) and since claim 2 of the copending application, recite the instantly claimed steps.

Conclusion


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maribel Medina whose telephone number is (571) 272-1355.

The examiner can normally be reached on Monday through Thursday from 7:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on (571) 272-1358. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1700.


Maribel Medina
Examiner
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